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09/332,489	06/14/1999	ARNAUD CAPITANT	S828.312-2	3010

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/332,489
Filing Date: June 14, 1999
Appellant(s): CAPITANT ET AL.

Paper No. 24

MAILED

JAN 14 2004

GROUP 3600

JEFFREY D. SHEWCHICK
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 2nd, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,236,851	Fourgnies et al	05-2001
6,366,967	Wagner	4-2002

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fourgnies et al (U.S. Patent No 6,236,851) in view of Wagner (U.S. Patent 6,366,967)

3. As per claims 1, 21 and 22, Fourgnies et al teaches a process/system/mobile radiotelephone for remote and secure payment (*payment telecommunication system, 10, 30*) for goods and/or a service (*calls*) purchased by a buyer (*preauthorized user, subscriber*) from a supplier (*cellular service provider, 14*), making use of a mobile radiotelephone (*cellular radiotelephone*) used by the buyer, the mobile radiotelephone enabling access to a radio communications network (*cellular communication network*) managed by a management center (*remote server, 18*) a payment server (*remote database 19*) being connected to the radio communications network (*see abstract, fig 1, 2, column 5 lines 22-6 line 62*), characterized by identification of the buyer by the management center and/or the payment server and/or a control center, the buyer identification consisting of making sure that the buyer is a subscriber correctly

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registered on a list of subscribers to the radio communications network (*see abstract, fig 1, 2 column 3 line 50-4 line 56*). Fourgnies et al. fail to teach a supplier within an open network.

Wagner teaches a supplier within an open network (*see fig 13A, column 5 lines 29-42*).

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Fourgnies et al's inventive concept to include Wagner's concept of a supplier within an open network because this would have supported electronic transactions or data compilation in a secure manner without undue limitation as to the devices with which communication may be made.

4. As per claim 2, Fourgnies et al teaches a process characterized in that the buyer identification by subscriber identification (*ANI and DNIS*), enabling the management center and/or the payment server and/or the control center to receive a subscriber identifier specific to the buyer, as a user of the radio communications network; subscriber authentication, enabling the management center and/or the payment server and/or the control center to check the subscriber identifier that was sent to it during the subscriber identification step (*see column 3 lines 50-4 line 4*).

5. As per claim 3, Fourgnies et al teaches a process characterized by the management center and/or the payment server and/or the control center supplies a random number to the mobile radiotelephone; the mobile radiotelephone generates a subscriber's electronic signature: with an individual authentication algorithm and/or an individual authentication key contained in protected areas of the mobile radiotelephone, and using the random number; the mobile

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radiotelephone transmits the subscriber's electronic signature to the management center and/or to the payment server and/or to the control center; the management center and/or the payment server and/or the control center checks the subscriber's electronic signature (*see abstract, fig 1, 2 column 3 line 50-4 line 56*).

6. As per claim 4, Fourgnies et al teaches a process characterized that management center and/or the payment server and/or the control center authenticates the buyer, and possibly a decision to purchase the goods and/or service purchased by the buyer (*see column 3 lines 50-4 line 4*).

7. As per claim 5, Fourgnies et al teaches a process, characterized that the radiotelephone generates a buyer's electronic signature, the mobile radiotelephone sends the buyer's electronic signature to the management center and/or the payment server and/or the control center; the management center and/or the payment server and/or the control center checks the buyer's electronic signature, the buyer's electronic signature being kept available for use by the buyer and the supplier (*see abstract, fig 1, 2 column 3 line 50-4 line 56*).

8. As per claim 6, Fourgnies et al teaches a process characterized in that the buyer authentication step, and possibly the purchase decision step, itself comprises the following steps: the buyer may input a confidential payment code into the mobile radiotelephone, using a keypad associated with the mobile radiotelephone, the mobile radiotelephone sends a secure transmission of the confidential payment code to the management center and/or the payment

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server and/or the control center; the management center and/or the payment server and/or the control center checks the confidential payment code (*see column 6 lines 7-27*).

9. As per claim 7, Fourgnies et al teaches a process characterized that the buyer inputs a confidential payment code into the mobile radiotelephone using a keypad associated with the mobile radiotelephone (*see abstract, fig 1, 2 column 3 line 50-4 line 56*).

10. As per claim 8, Fourgnies et al teaches a process characterized in that the step in which the confidential payment code is input, is made using an input algorithm stored in the mobile radiotelephone (*see column 3 lines 50-4 line 4*).

11. As per claim 9, Fourgnies et al teaches a process characterized that the confidential payment code is input, is made using at least one downloaded page in the HDML or an equivalent format provided for this purpose (*see column 3 lines 50-4 line 4*).

12. As per claim 10, and 11, Fourgnies et al teaches a process characterized in that the step in which the buyer's electronic signature is generated is carried out: using a payment security algorithm and/or a payment security key contained in the protected areas of the mobile radiotelephone, and starting from data about the transaction and/or data about the buyer (*see column 3 lines 50-4 line 4*).

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13. As per claim 12, Fourgnies et al teaches a process wherein the mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the payment security algorithm and/or the payment security key is stored in protected areas of the terminal (*see column 3 lines 50-4 line 4*).

14. As per claim 13, Fourgnies et al teaches a process wherein the mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the payment security algorithm and/or the payment security key is (are) stored in protected areas of the subscriber identification module (*see column 6 lines 28-67*).

15. As per claim 14, Fourgnies et al teaches a process characterized that the mobile radiotelephone is unlocked if a comparison between a confidential identification code (PIN code) contained in protected areas of the mobile radiotelephone, and a secret key known to the buyer and input by the buyer into the mobile radiotelephone using a keypad is positive (*see column 7 lines 44-8 line 40*).

16. As per claim 15, Fourgnies et al teaches a process the mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that at least one some of the protected areas of the mobile radiotelephone are included in the subscriber identification module *see column 7 lines 44-8 line 40*).

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17. As per claim 16, Fourgnies et al teaches a process characterized in that it also comprises the following data related to payment for the purchase of goods and/or the service are encrypted, exchanged between the mobile radiotelephone and the management center and/or the payment server and/or the control center, to ensure that the purchase is confidential (*see column 3 lines 50-4 line 4*).

18. As per claim 17, Fourgnies et al teaches a process characterized in that it also comprises the following a check of the integrity of data related to payment for the purchase of goods and/or the service exchanged between the mobile radiotelephone and the management center and/or the payment server and/or the control center, so that a defrauder is unable to modify the data (*see abstract, fig 1, 2, column 5 lines 22-6 line 62*).

19. As per claim 18, Fourgnies et al teaches a process characterized in that the buyer is associated with an electronic wallet comprising: a wallet identifier associated with a subscriber identifier specific to the buyer, as a user of the radio communications network; means of payment information about the buyer and/or the account(s) of the buyer; use of the means of payment, particularly when buying goods and/or a service not being authorized until the buyer has been successfully identified, and possibly authenticated (*see abstract, fig 1, 2 column 3 line 50-4 line 56*).

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20. As per claim 19, Fourgnies et al teaches a process characterized in that the electronic wallet also comprises a confidential payment code known to the buyer (*see abstract, fig 1, 2 column 3 line 50-4 line 56*).

21. As per claim 20 Fourgnies et al teaches a process the mobile radiotelephone comprising a terminal cooperating with a subscriber identification module, characterized in that the electronic wallet is stored in one of the elements belonging to the group consisting of: the terminal the subscriber identification module the payment server the management center the control center (*see abstract, fig 1, 2, column 5 lines 22-6 line 62*).

(11) Response to Argument

First and foremost, Appellants disclose an inventive concept of “identification of the buyer by the management center and /or the payment center and/or a control center based on a request from the supplier within the open network.” Given the manner in which the claim is written, and its interpretation, the phrase “based on a request from the supplier within the open network” is considered part of the third option. Therefore, the identification can be done by any of the options listed and the third option which is argued, is not needed in order for the inventive concept to be operable.

Appellants argue that the prior art (Fougnies and Wagner) fail to teach an inventive concept wherein a consumer/user is able to purchase good or services. Although applicant conceded that Fougnies disclose a concept of purchasing access time, Appellants argues that access time cannot be considered as good/services. Examiner respectfully disagrees with Appellants characterization of Fougnies’s inventive concept. Fougnies disclose an invention that

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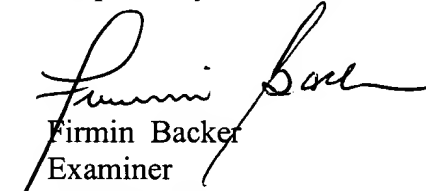
allows a pre-paid user to access the cellular telecommunication system and have authentication and accounting occur. The present invention accomplishes this by using the ANI as the file link to identify and authenticate the cellular telephone against the database. Thus, cellular telephone users are freed of the need to carry and use cards, are freed of the need to enter account information as a first step in the authentication process and the possibility of fraud on the cellular service providers is minimized. The present invention further allows pre-paid subscribers to conveniently purchase additional airtime and pay monthly access fees. It is obvious that the purchasing of additional airtime is the same as purchasing good or services (*see column 4 lines 33-51*). Applicant further argues that Wagner fail to teach the purchasing of good/service in an open network. Examiner respectfully disagrees with applicant characterization of Wagner's inventive concept. Wagner teach and invention provides transaction and data systems which may be implemented on an open network (*see abstract, fig 12, column 5 lines 45-57*). Wagner's inventive concept provides a system may be used to execute a transaction between a consumer and a merchant so the merchant receives remittance information in a timely manner. The system permits the consumer to initiate a transaction and order from a merchant and then use a more secure link supported by PIN entry devices or the like to reduce the risk of fraud for the transaction. Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching of Fougnes and Wagner are closely related and the combination of the teaching would have been obvious for one of ordinary skill in the art.


For the above reasons, Examiner believes that the rejections should be sustained.

Respectfully submitted,

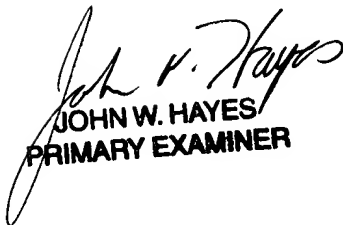

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January 12, 2004

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